



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,400	11/29/2001	Chulso Moon	P-CAN 1004	4431

7590 07/28/2005

LISA M HEMMENDINGER
BANNER & WITCOFF LTD
1001 G STREET NW
ELEVENTH FLOOR
WASHINGTON, DC 20001-4597

EXAMINER

YU, MISOOK

ART UNIT PAPER NUMBER

1642

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,400

Applicant(s)

MOON ET AL.

Examiner

MISOOK YU, Ph.D

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 43-57 is/are pending in the application.
- 4a) Of the above claim(s) 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 43-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's reply filed on 05/16/2005 is acknowledged. Claim 57 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 1 and 43-57 are pending, and claims 1 and 43-56 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This Office action contains new ground of rejection.

Specification, Withdrawn

The objection of the specification is withdrawn in view of the amendment.

Claim Rejections - 35 USC § 112, Withdrawn

The rejection of claim 52 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment.

Claim Rejections - 35 USC § 102, Withdrawn

The rejection of claims 1, 43, and 45, and 48-54 are rejected under 35 U.S.C. 102(a) as being anticipated by Tang et al., (IDS, 9/20/2000, Journal of the National Cancer Institute; vol. 92, pages 1511-1516) is withdrawn because the Dr. Mao' declaration under 37 CFR 1.132 filed 16 May 2005 is sufficient to overcome the rejection of record.

Art Unit: 1642

Claim Rejections - 35 USC § 103, Withdrawn

All 103(a) rejections of record are also withdrawn because Tang et al., are no longer prior art.

The Following Are New Grounds of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 43-56 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methylation detection at DAP-kinase promoter, does not reasonably provide enablement for any other part of DAP-kinase gene. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The factors considered when determining if the disclosure satisfies the enablement requirement and whether any necessary experimentation is ☐undue☐ include, but are not limited to: 1) nature of the invention, 2) state of the prior art, 3) relative skill of those in the art, 4) level of predictability in the art, 5) existence of working examples, 6) breadth of claims, 7) amount of direction or guidance by the inventor, and 8) quantity of experimentation needed to make or use the invention. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The claims are interpreted as drawn to method of diagnosing (claims 1, 43, 45, 48-51) non-small cell lung cancer (NSCLC), assessing NSCLC tumorigenesis at an

Art Unit: 1642

early stage of NSCLC (claim 52), or assessing aggressiveness of a NSCLC (claims 53) in a human patient, wherein the active step of the claimed method comprises assessing the expression of DAP-kinase gene and detection of lower expression of the gene is indicative of NSCLC, or bad outcome for the patient, wherein the expression is assessed in vitro using cells obtained from the human (claim 43), wherein the cells are epithelial cells (claim 45), wherein the expression of the gene is assessed by assessing methylation of the gene (claim 48), wherein methylation of the promoter CpG region is assessed (claim 49), wherein a first oligonucleotide hybridizing specifically to a methylated form of the gene is used (claim 50), wherein a portion of the gene is amplified by a PCR using two primers (claim 51), wherein the tumor in claim 53 is a diagnostic stage I NSCLC tumor (claim 54).

The teaching of the specification is limited to methylation detection at DAP-kinase promoter. Tang et al., teach at the title that hypermethylation of the DAP kinase "promoter" is associated with lung cancer. However, neither the specification nor any other art teaches that methylation of any other part of DAP-kinase gene is associated with NSCLC. It is noted that law requires that the disclosure of an application shall inform those skilled in the art how to make the alleged discovery, not how to screen it for themselves.

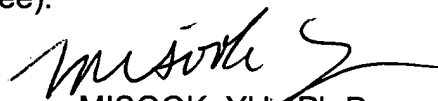
Considering the unpredictable state of art, limited guidance, broad breath of the claims, it is concluded that undue experimentation is required to the full scope of the practice the invention. Limiting the scope to the detection of methylation to the promoter would obviate this rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D whose telephone number is 571-272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MISOOK YU, Ph.D
Examiner
Art Unit 1642